

Application No.: 10/772,915

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Docket No.: 297912003410

**REMARKS**

The Office Action dated March 8, 2006 has been reviewed and the Examiner's comments considered. The specification has been amended, the title being changed pursuant to the Examiner's requirement. Claims 1-16 are pending in this application. Claims 9 and 10 have been amended and claim 16 has been added, support for which can be found in the originally filed disclosure at paragraph [0019]. No new matter or issues have been introduced.

Claim 10 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claim 10 to cure the antecedent basis issue recognized by the Examiner. Applicants have reviewed the pending claims and believe that all comply with 35 U.S.C. § 112, second paragraph and, hence, request withdrawal of this rejection.

**Claim Rejections - 35 U.S.C. § 102**

Claims 1-5 and 9-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by USPN 6,187,054 to Colone et al. Applicants respectfully traverse this rejection.

Independent claim 1 recites, *inter alia*, "heating said calendered tube above the crystalline melt-point for polytetrafluoroethylene while maintaining said second inner diameter substantially constant." Independent claim 9 recites, *inter alia*, "heating said calendered tube above the crystalline melt-point for polytetrafluoroethylene while maintaining said first inner diameter substantially constant." In both independent claims, it is required to heat the calendered tube above the crystalline melt-point for polytetrafluoroethylene while the diameter of the tube is maintained substantially constant. In the case of claim 1, this step is performed following radial dilation to the second inner diameter (in other words, it is this second inner diameter that is maintained substantially constant, which doesn't allow for an intervening radial contraction step). In the case of claim 9, as amended, this step is performed at an extruded first inner diameter (which also doesn't allow for an intervening radial contraction step).

Colone et al. shows and describes a method of making ePTFE prostheses with relatively large diameters and/or thin walls, the prostheses consisting of composite structures made of at least

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two layers of ePTFE, liners for stents and other composite devices. (col. 2, lines 16-26). Colone et al. provides several examples of structures according to the invention, including two or more tubes that are superimposed and are sintered together, inserting a stent between the two tubes, and producing a single tube. (col. 2, line 43 through col. 3, line 14). In each case, the tube or tubes are subjected to progressive radial dilation and calendering, after which they are heated to about 200°C to contract the tube or tubes slightly to a smaller diameter. (col. 2, lines 34-42). Importantly, each of the examples (*see* col. 3, lines 11-14; col. 5, lines 61-64; and col. 7, lines 32-35) describes contraction of the tube through heating after a final diameter is obtained, but before sintering (i.e., heating above the crystalline melt-point for polytetrafluoroethylene).

As set forth in MPEP § 2131 (Eighth Edition, Revision 3, August 2005, p. 2100-76), a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicants submit that Colone et al. does not show or describe each and every element of either independent claim 1 or independent claim 9 as amended. Specifically, Colone et al. does not show or describe either "heating said calendered tube above the crystalline melt-point for polytetrafluoroethylene while maintaining said second inner diameter substantially constant" (claim 1) or "heating said calendered tube above the crystalline melt-point for polytetrafluoroethylene while maintaining said first inner diameter substantially constant" (claim 9), as explained above. Accordingly, claims 1 and 9 are patentable over Colone et al. Claims 2-8 and 13-16 are also patentable over the proposed combination because these claims depend from claims 1 and 9, and also recite other features not shown or described in the relied-upon prior art.

#### **Claim Rejections - 35 U.S.C. § 103**

Claims 6-8 and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Colone et al. in view of USPN 5,207,960 to Moret de Rocheprise. Applicants respectfully traverse this rejection.

Claims 6-8 are dependent on claim 1 and claims 13-15 are dependent on claim 9, each of which (claims 1 and 9) are believed to be patentable in view of the above. Moreover, Applicants submit that Moret de Rocheprise does not show or describe the missing steps of "heating said

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calendered tube above the crystalline melt-point for polytetrafluoroethylene while maintaining said second inner diameter substantially constant" (claim 1) and "heating said calendered tube above the crystalline melt-point for polytetrafluoroethylene while maintaining said first inner diameter substantially constant" (claim 9), in which the second inner diameter and first inner diameter, respectively, have particular meanings as set forth in the claims. Thus a *prima facie* case of obviousness has not been established as set forth in MPEP § 2143.03 (MPEP 8th Ed., Rev. 2, August 2005), as all of the claimed features are not taught or suggested by the prior art. Accordingly, claims 6-8 and 13-15 are patentable over Colone et al. in view of Moret de Rocheprise for at least this reason.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 297912003410. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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